

***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE***

Applicants: Barbara S. SLUSHER *et al.*

Title: NAALADASE INHIBITORS FOR TREATING  
RETINAL DISORDERS AND GLAUCOMA

Appl. No.: 09/866,961

Filing Date: 05/30/2001

Examiner: Zohreh A. FAY

Art Unit: 1614

**REQUEST FOR RECONSIDERATION UNDER 37 CFR § 1.181**

Mail Stop PETITIONS  
Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

Sir:

In reply to the Petition Decision dated September 21, 2002, denying applicants' Request For Withdrawal Of Office Actions, applicants submit this Request for Reconsideration.

Applicants provide below a chronology of events that resulted in the current state of abandonment for this application.

## CHRONOLOGY

1. Applicants filed the instant application on May 30, 2001.
2. On October 23, 2002, the Office issued a restriction requirement.
3. Applicants filed a response to the restriction requirement on November 12, 2002.
4. The Office issued a first non-final action on the merits on February 14, 2003.
5. On May 12, 2003, applicants filed a response to the Office action of February 14, 2003.
6. The Office issued a second non-final action on the merits on September 16, 2003.
7. On December 16, 2003, applicants transmitted, via facsimile, a response to the Office action of September 16, 2003.
8. The Office issued a final action on January 29, 2004, noted as being responsive to amendments and remarks filed by applicants on October 17, 2003. Without addressing applicants' response filed on December 16, 2003, the action reiterated the arguments previously presented in the non-final action of September 16, 2003.
9. Applicants' counsel called and left messages with Examiner Zoreh Fay on February 18, 2004 and February 24, 2004.
10. On February 25, 2004, applicants' counsel successfully reached Examiner Fay by phone, and requested withdrawal of the final action. Examiner Fay said that she was not aware of the response filed December 16, 2003, and requested a copy thereof.
11. On February 26, 2004, applicants' counsel transmitted to Examiner Fay, via facsimile, a copy of the response filed December 16, 2003.
12. On March 8, 2004, applicants' counsel called and left a message with Examiner Fay, inquiring as to the status of applicants' request for withdrawal of final action.
13. In a telephone discussion with applicants' counsel on April 8, 2004, Examiner Fay said that she did not receive a copy of applicants' facsimile of February 26, 2004, and requested applicants' counsel to resend a copy of the response filed December 16, 2003.
14. On April 8, 2004, applicants' counsel sent to Examiner Fay, via facsimile, yet another copy of the response filed December 16, 2004.

15. On April 14, 2004, applicants' counsel called Examiner Fay to inquire about the status of applicants' request for withdrawal of final action. Examiner Fay said that she would get back to us.
16. With no word from Examiner Fay, applicants' counsel called and left a message with SPE Marianne Seidel on April 28, 2004.
17. On April 29, 2004, SPE Seidel agreed in a telephone conference with applicants' counsel to withdraw the final action.
18. On July 7, 2004, the Office mailed an advisory action, stating that applicants' response of April 8, 2004, failed to place the application in condition for allowance.
19. On July 12, 2004, applicants' counsel called SPE Seidel, who informed applicants' counsel that she was no longer responsible for the application, and directed applicants' counsel to SPE Christopher Low.
20. On July 12, 2004, applicants' counsel called and left a message with SPE Low.
21. In a telephone conference with SPE Low on July 16, 2004, applicants' counsel restated reasons for requesting withdrawal of final action. SPE Low suggested that applicants' counsel submit request in writing.
22. On July 19, 2004, at SPE Low's suggestion, applicants filed a Request for Withdrawal of Office Actions.
23. On July 28, 2004, applicants called and left a message with SPE Low inquiring as to the status of applicants' request.
24. In a telephone conference with applicants' counsel on July 29, 2004, SPE Low agreed to vacate the final Office action and the advisory action, and transmitted via facsimile an Interview Summary memorializing the same. Upon receipt of the Interview Summary, applicants' counsel called and left a message with SPE Low requesting correction of the application number and the applicants' name on the Interview Summary.
25. On August 9, 2004, Examiner Fay issued a new Interview Summary confirming withdrawal of the final Office action and advisory action, with corrected application number and applicants' name.
26. On September 10, 2004, the Director of Technology Center 1600 mailed a Petition Decision, treating applicants' request for withdrawal as a petition under 37 CFR 1.181, nullifying SPE Low's and Examiner Fay's Interview Summaries and denying

applicant's request. Applicants' counsel never received the originally issued Petition Decision and learned of it only following receipt of the Notice of Abandonment.

27. The Office issued a Notice of Abandonment on September 21, 2004.

### REMARKS

Applicants respectfully request reconsideration of the Petition Decision for the reasons that follow.

In large measure, the Petition Decision was based on information that had been erroneously entered into the Office's Patent Application Information Retrieval (PAIR) system.

1. *PAIR shows duplicate entries for applicants' response filed May 12, 2003*

Attached are copies of the Transaction History (Tab 1) and Image File Wrapper (Tab 2) as retrieved from public PAIR. Yellow highlights on these documents illustrate that applicants' response filed May 12, 2003, was entered twice: first, as a response to the non-final Office action dated February 14, 2003; and second, as a response to the non-final Office action dated September 16, 2003.

2. *Contrary to final Office action, applicants did not file a response on October 17, 2003*

As a result of the erroneous second entry, Examiner Fay issued a final action on January 29, 2004, as being responsive to applicants' "amendments and remarks filed on October 17, 2003" (see page 2).

Applicants' records do not show that a response was filed on October 17, 2004. The Office's copy of the alleged response (Tab 3), which accompanied the Petition Decision, reveals that it is identical to the response filed May 12, 2003 (Tab 4). Both documents were dated May 12, 2003, and refer to the Office action dated February 14, 2003.

3. *Office had no record of applicants' response filed December 16, 2003, when final action was issued*

In view of the document's date of signing and reference to the Office action of February 14, 2003, the alleged response filed October 17, 2003, is clearly not responsive to the Office action dated September 16, 2003. Nevertheless, the Office treated it as such, and issued a final action without considering the arguments presented in applicants' actual response filed December 16, 2004.

It is evident from the Transaction History (Tab 1) that at the time that Examiner Fay issued the final action, the Office had no record of applicants' response filed December 16, 2004. Consequently, the final action did not address any of the arguments presented in that response.

4. *PAIR shows duplicate entries for response filed December 16, 2003*

Applicants' repeated efforts to fax to Examiner Fay copies of the response filed December 16, 2003, only complicated matters. For example, the Office recorded the facsimile transmission of April 8, 2004, as an "Amendment after Final Rejection". See green highlights in attached Transaction History (Tab 1) and Image File Wrapper (Tab 2).

### CONCLUSION

Based on the foregoing reasons, applicants respectfully request that the Petition Decision be reconsidered and withdrawn, and that the Office's records be corrected to reflect the dates as presented in the actual file history (Tab 5).

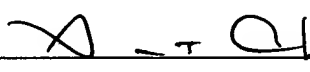
The Office is invited to contact the undersigned by telephone with any questions.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even

entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date November 10, 2004

By 

FOLEY & LARDNER

Customer Number: 29728

Telephone: (202) 295-4163

Facsimile: (202) 672-5399

Suet M. Chong  
Attorney for Applicants  
Registration No. 38,104



Atty. Dkt. No. 054707-0868

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JFW  
P

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Barbara S. SLUSHER *et al.*

Title: NAALADASE INHIBITORS FOR TREATING RETINAL  
DISORDERS AND GLAUCOMA

Appl. No.: 08/866,961

Filing Date: 05/30/2001

Examiner: Zohreh A. FAY

Art Unit: 1614

**TRANSMITTAL LETTER**

Mail Stop: Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Transmitted herewith are:

1. Request for Reconsideration of Applicant's Petition Under 37 CFR § 1.181
2. Transaction History from PAIR as Tab 1
3. Image File Wrapper from PAIR as Tab 2
4. Copy of alleged response filed October 17, 2003 as Tab 3
5. Copy of response filed May 12, 2003 as Tab 4
6. Actual file history as Tab 5
7. Copy of Petition Decision dated September 10, 2004

Although Applicants believe that no fee is due, the Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Respectfully submitted,

Date November 10, 2004 By A-T CL

FOLEY & LARDNER LLP

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Suet M. Chong

Attorney for Applicant

Registration No. 38,104





UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

SEP 10 2004

GUILFORD PHARMACEUTICALS CO.  
FOLEY & LARDNER  
3000 K STREET, NW  
WASHINGTON, DC 20007-5143

In re Application of  
Barbara S. Slusher et al  
Serial No.: 09/866,961  
Filed: May 30, 2001  
Attorney Docket No.: 264/239

:  
:  
: PETITION DECISION  
:  
:

This is in response to the petition under 37 CFR 1.181, filed July 19, 2004, requesting withdrawal of the Final Office action.

A review of the file history shows that the examiner mailed a non-Final Office action to applicants on February 14, 2003. Applicants replied to this Office action on May 12, 2003, canceling claims 1-24 and 27-49, amending claim 25 and presenting new claims 50-58 and responding to the outstanding rejections. The examiner mailed a new non-Final Office action to applicants on September 16, 2003, setting forth a new rejection of the pending claims. Applicants (contrary to the petition assertion) replied to this Office action on October 17, 2003. (Copy enclosed) The response of October 17, 2003, is identical to the reply made May 12, 2003. A further response was made December 16, 2003, which specifically refers to the September 16, 2003, Office action. The examiner then mailed a Final Office action to applicants on January 29, 2004, maintaining the rejection of the Office action of September 16, 2003. Applicants filed an amendment in response to the Final Office action on April 8, 2004. The amendment (argument only) makes no request to withdraw the finality of the Final Office action. The examiner mailed an Advisory Action to applicants on July 7, 2004, indicating entry of the amendment, but failure to overcome the rejection of record. Applicants also initiated a telephone interview with the examiner's supervisor (see interview summary mailed August 9, 2004) seeking withdrawal of the Final Office action and Advisory Action. This petition was filed prior to the interview.

As seen from the above chronology of Office actions and responses, conduct of prosecution was proper and the finality of the last Office action was proper. Applicants claim that no response was filed on October 17, 2003. However the application file record shows a response being filed on that date which was initially accepted as a response to the Office action of September 16, 2003. The later response of December 16, 2003, was a more proper reply to the Office action. Had no response been filed the application would have become abandoned on March 17, 2004. However, as can be seen from the record responses were made which required the examiner to reexamine the application and issue a new, in this case Final, Office action. In view of the

above, no good or sufficient reason has been given for withdrawal of the finality of the Office action mailed January 29, 2004.

Further, a request to withdraw an improper Office action by an examiner under 37 CFR 1.181 must be filed within two months of the action complained of (37 CFR 1.181(f)). Such appears not to be the case here. The request to have the Final Office action withdrawn was not made in the response filed April 8, 2004, as it should have been, but appears to have first been filed six months after the action was taken in this petition and can therefore also be dismissed as untimely.

The petition is **DENIED**. The supervisor's indication that the Office action of January 29, 2004, is withdrawn was improper and not based on a complete understanding of the record and is vacated. Further, as a consequence of failure to properly reply to a Final Office action this application stands abandoned. A Notice of Abandonment will be forthcoming.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number.



Bruce M. Kisliuk  
Director, Technology Center 1600

Printer Friendly

09/866,961 Naaladase inhibitors for treating retinal disorders and glaucoma

## Transaction History

Date	Contents Description
09-21-2004	Mail Abandonment for Failure to Respond to Office Action
09-17-2004	Abandonment for Failure to Respond to Office Action
09-10-2004	Petition Decision - Denied
07-19-2004	Petition Entered
08-09-2004	Mail Examiner Interview Summary (PTOL - 413)
08-05-2004	Examiner Interview Summary Record (PTOL - 413)
07-19-2004	Workflow incoming amendment IFW
07-07-2004	Mail Advisory Action (PTOL - 303)
07-06-2004	Advisory Action (PTOL-303)
04-19-2004	Date Forwarded to Examiner
04-08-2004	Amendment after Final Rejection
01-29-2004	Mail Final Rejection (PTOL - 326)
01-26-2004	Final Rejection
11-19-2003	Date Forwarded to Examiner
05-12-2003	Response after Non-Final Action
09-16-2003	Mail Non-Final Rejection
09-16-2003	Non-Final Rejection
05-21-2003	Date Forwarded to Examiner
05-12-2003	Response after Non-Final Action
02-14-2003	Mail Non-Final Rejection
02-10-2003	Non-Final Rejection
11-21-2002	Date Forwarded to Examiner
11-12-2002	Response to Election / Restriction Filed
10-23-2002	Mail Restriction Requirement
10-01-2002	Requirement for Restriction / Election
05-30-2001	Payment of additional filing fee/Preexam
03-28-2002	Information Disclosure Statement (IDS) Filed
08-30-2001	Information Disclosure Statement (IDS) Filed
08-21-2001	Case Docketed to Examiner in GAU
08-16-2001	Application Dispatched from OIPE
07-26-2001	Application Is Now Complete
07-26-2001	Notice Mailed--Application Incomplete--Filing Date Assigned
07-25-2001	Correspondence Address Change
06-07-2001	IFW Scan & PACR Auto Security Review
05-30-2001	Initial Exam Team nn

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09/866,961 Naaladase inhibitors for treating retinal disorders and glaucoma

Image File Wrapper

This application is officially maintained in electronic form. To View: Click the desired Document Description. To Download and Print: Check the desired document(s) and click StartDownload.

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09-21-2004	Abandonment	2
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07-19-2004	Amendment	5
07-19-2004	Claim	4
07-19-2004	Applicant Arguments or Remarks Made in an Amendment	2
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07-19-2004	Applicant Arguments or Remarks Made in an Amendment	3
07-19-2004	Letter Withdrawing/Vacating Office Action	2
07-07-2004	Advisory Action (PTOL-303)	2
04-08-2004	<del>Amendment</del>	5
04-08-2004	<del>Applicant Arguments or Remarks Made in an Amendment</del>	3
01-29-2004	Final Rejection	4
01-29-2004	Claims recorded on File Wrapper	1
01-29-2004	Claim	5
01-29-2004	Applicant Arguments or Remarks Made in an Amendment	2
01-29-2004	Search info on File Wrapper	1
12-16-2003	<del>Amendment</del>	4
12-16-2003	<del>Applicant Arguments or Remarks Made in an Amendment</del>	3
10-17-2003	Amendment	1
10-17-2003	Claim	4
10-17-2003	Applicant Arguments or Remarks Made in an Amendment	2

09-16-2003	Non-Final Rejection	4
05-12-2003	Amendment	3
05-12-2003	Claim	4
05-12-2003	Applicant Arguments or Remarks Made in an Amendment	2
04-11-2003	Change of Address	1
02-14-2003	Non-Final Rejection	4
02-14-2003	List of references cited by Examiner	1
02-14-2003	List of References cited by Applicant	1
02-02-2003	Examiner Search Notes	100
11-12-2002	Amendment	3
10-23-2002	Requirement for Restriction/Election	5
07-11-2002	Miscellaneous Incoming Letter	1
06-28-2002	Specification	2
05-29-2002	Change of Address	1
03-28-2002	Information Disclosure Statement	2
03-28-2002	NPL Documents	7
03-28-2002	Foreign Reference	12
03-28-2002	NPL Documents	4
08-30-2001	Foreign Reference	241
08-30-2001	Foreign Reference	65
08-30-2001	NPL Documents	9
08-30-2001	NPL Documents	7
08-30-2001	NPL Documents	6
08-30-2001	NPL Documents	28
08-30-2001	NPL Documents	8
08-30-2001	NPL Documents	9
08-30-2001	NPL Documents	3
08-30-2001	NPL Documents	16
08-30-2001	NPL Documents	8
08-30-2001	NPL Documents	5
08-30-2001	NPL Documents	12

08-30-2001	NPL Documents	6
08-30-2001	Information Disclosure Statement	5
08-30-2001	Foreign Reference	258
08-15-2001	Miscellaneous Action with SSP	1
07-26-2001	Miscellaneous Action with SSP	1
05-30-2001	Issue Information on File Wrapper	1
05-30-2001	Search info on File Wrapper	1
05-30-2001	Claims recorded on File Wrapper	1
05-30-2001	Transmittal of New Application	3
05-30-2001	Drawings	3
05-30-2001	Specification	156
05-30-2001	Claim	37
05-30-2001	Abstract	1
05-30-2001	Oath or Declaration filed	3
05-30-2001	Fee Worksheet (PTO-875)	1
05-30-2001	Fee Worksheet (PTO-875)	1
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05-30-2001	Transmittal of New Application	3
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Atty. Dkt. No. 054707-0868

*IN THE UNITED STATES PATENT AND TRADEMARK OFFICE*

Applicants: Barbara S. SLUSHER et al.

Title: NAALADASE INHIBITORS FOR  
TREATING RETINAL  
DISORDERS AND GLAUCOMA

Appl. No.: 09/866,961

Filing Date: 05/30/2001

Examiner: Zohreh A. FAY

Art Unit: 1614

RECEIVED  
OCT 20 2003  
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AMENDMENT AND RESPONSE UNDER 37 CFR 1.111

Mail Stop NON-FEE AMENDMENT  
Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

Sir:

This communication is responsive to the Non-Final Office Action dated February 14, 2003, concerning the above-referenced patent application. Since this communication is filed within the three month period for response, no extension of time is required.

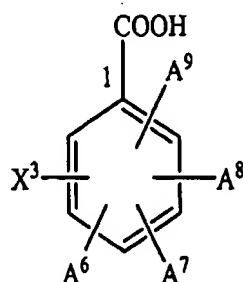
The amendments presented below are in compliance with the revised amendment format permitted in the Notice from the Office of Patent Legal Administration of the U.S. Patent and Trademark Office dated February 10, 2003, and published at 1267 OG 106 on February 25, 2003. Thus, the provisions of 37 CFR 1.121(a), (b), (c) and (d) are waived for amendments made in this application.

Please amend the application as follows.

Listing of Claims:

Claims 1-24 (canceled)

**Claim 25 (currently amended):** ~~The method of claim 1, wherein the NAALADase inhibitor~~  
is A method for treating retinopathy, age-related macular degeneration or glaucoma comprising  
administering to a mammal in need of such treatment an effective amount of a compound of  
 formula X



X

or an enantiomer or a pharmaceutically acceptable equivalent of said compound, wherein:

$X^3$  is  $-(CR^{36}R^{37})_nSH$ ,  $-O(CR^{36}R^{37})_2SH$ ,  $-S(CR^{36}R^{37})_2SH$  or  $-NR(CR^{36}R^{37})_2SH$ ;

$n$  is 1-3; and

$R$ ,  $R^{36}$ ,  $R^{37}$ ,  $A^6$ ,  $A^7$ ,  $A^8$  and  $A^9$  are independently hydrogen,  $C_1$ - $C_9$  alkyl,  $C_2$ - $C_9$  alkenyl,  $C_2$ - $C_9$  alkynyl, aryl, heteroaryl, carbocycle, heterocycle, halo, hydroxy, sulfhydryl, nitro, amino, cyano, isocyano, thiocyno, isothiocyno, formamido, thioformamido, sulfo, sulfinio,  $C_1$ - $C_9$  alkylsulfonyl,  $C_1$ - $C_9$  alkoxy,  $C_2$ - $C_9$  alkenoxy, phenoxy or benzyloxy, wherein said alkyl, alkenyl, alkynyl, aryl, heteroaryl, carbocycle, heterocycle, alkoxy, alkenoxy, phenoxy and benzyloxy are independently unsubstituted or substituted with one or more substituent(s).

**Claim 26 (original)** The method of claim 25, wherein the compound of formula X is selected from the group consisting of:



3-(2-mercaptoethyl)-benzoic acid;  
3-(mercaptomethyl)-benzoic acid;  
2-(mercaptomethyl)-benzoic acid;  
5-hydroxy-2-(2-mercaptoethyl)-benzoic acid;  
2-(2-mercaptoethyl)-benzoic acid;  
5-[(4-carboxyphenyl)methoxy]-2-(2-mercaptoethyl)-benzoic acid;  
2-(2-mercaptoethyl)-5-(phenylmethoxy)-benzoic acid;  
2-(carboxymethoxy)-6-(2-mercaptoethyl)-benzoic acid;  
5-[(3-carboxyphenyl)methoxy]-2-(2-mercaptoethyl)-benzoic acid;  
2-(2-mercaptoethyl)-6-(phenylmethoxy)-benzoic acid;  
2-[(2-carboxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-[(4-carboxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
3-(2-mercaptoethyl)-[1,1'-biphenyl]-2,3'-dicarboxylic acid;  
2-(3,3-dimethylbutoxy)-6-(2-mercaptoethyl)-benzoic acid;  
2-(2-mercaptoethyl)-6-(phenylethoxy)-benzoic acid;  
2-[(2-chlorophenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-[[3-carboxy-5-(1,1-dimethylethyl)phenyl]methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-(2-mercaptoethyl)-6-phenoxy-benzoic acid;  
2-(2-mercaptoethyl)-6-phenylamino-benzoic acid;  
2-(2-mercaptoethyl)-6-(phenylthio)-benzoic acid;  
5'-(1,1-dimethylethyl)-3-(2-mercaptoethyl)-[1,1'-biphenyl]-2,3'-dicarboxylic acid;  
3-(2-mercaptoethyl)-[1,1'-biphenyl]-2,4'-dicarboxylic acid;  
2-[(4-carboxy-2-methoxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-[(4-carboxy-3-methoxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-[(2-bromo-4-carboxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-[(3-bromo-4-carboxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-[(4-chlorophenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-(biphenyl-2-ylmethoxy)-6-(2-mercaptoethyl)-benzoic acid;

2-[(3-bromo-5-carboxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-[(2-bromo-5-carboxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-(2-mercaptoethyl)-6-[(4-methoxyphenyl)methoxy]-benzoic acid;  
2-(2-mercaptoethyl)-6-[(4-methylphenyl)methoxy]-benzoic acid;  
2-[(4-bromo-3-carboxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-[(2-carboxy-5-methoxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
5-(mercaptomethyl)-2-(2-phenylethoxy)-benzoic acid;  
2-bromo-5-(mercaptomethyl)-benzoic acid;  
4-(mercaptomethyl)-[1,1'-biphenyl]-2,3'-dicarboxylic acid;  
5-(mercaptomethyl)-2-(phenylmethoxy)-benzoic acid; and  
4-bromo-3-(mercaptomethyl)-benzoic acid; and  
enantiomers and pharmaceutically acceptable equivalents.

**Claims 27-49 (canceled)**

**Claim 50 (new):** The method of claim 25, wherein the method is for treating retinopathy.

**Claim 51 (new):** The method of claim 50, wherein the retinopathy is diabetic retinopathy.

**Claim 52 (new):** The method of claim 25, wherein the method is for treating age-related macular degeneration.

**Claim 53 (new):** The method of claim 25, wherein the method is for treating glaucoma.

**Claim 54 (new):** The method of claim 26, wherein the method is for treating retinopathy.

**Claim 55 (new):** The method of claim 54, wherein the retinopathy is diabetic retinopathy.

**Claim 56 (new):** The method of claim 26, wherein the method is for treating age-related macular degeneration.

**Claim 57 (new):** The method of claim 26, wherein the method is for treating glaucoma.

**Claim 58 (new):** A method for treating retinopathy or age-related macular degeneration comprising administering an effective amount of a NAALADase inhibitor to a mammal in need of such treatment.

**REMARKS**

Claims 1-24 and 27-49 are cancelled and claim 25 is amended to remove non-elected subject matter. New claims 50-58 are added. Upon entry of the foregoing amendments, claims 25, 26 and 50-58 would be pending.

Applicants respectfully request reconsideration of this application in view of the foregoing amendments and in view of the reasons which follow.

**35 U.S.C. 102(e)**

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Meyerhoff et al. In support of this rejection, the Office action states: "Meyerhoff et al. Teach [sic] the use of a NAALADase inhibitor for the treatment of glaucoma."

The foregoing amendments obviate this rejection.

**CONCLUSION**

Applicants believe that this application is now in condition for allowance. Favorable reconsideration of this application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of this application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date May 12, 2003

FOLEY & LARDNER  
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By Suet M. Chong

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Atty. Dkt. No. 09A707-0868

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED  
MAY 14 2003  
TECH CENTER 1600/2900  
#11/A  
5/21/03

Applicants: Barbara S. SLUSHER et al.

Title: NAALADASE INHIBITORS FOR  
TREATING RETINAL  
DISORDERS AND GLAUCOMA

Appl. No.: 09/866,961

Filing Date: 05/30/2001

Examiner: Zohreh A. FAY

Art Unit: 1614

AMENDMENT AND RESPONSE UNDER 37 CFR 1.111

Mail Stop NON-FEE AMENDMENT  
Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

Sir:

This communication is responsive to the Non-Final Office Action dated February 14, 2003, concerning the above-referenced patent application. Since this communication is filed within the three month period for response, no extension of time is required.

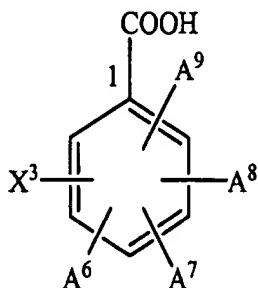
The amendments presented below are in compliance with the revised amendment format permitted in the Notice from the Office of Patent Legal Administration of the U.S. Patent and Trademark Office dated February 10, 2003, and published at 1267 OG 106 on February 25, 2003. Thus, the provisions of 37 CFR 1.121(a), (b), (c) and (d) are waived for amendments made in this application.

Please amend the application as follows.

Listing of Claims:

Claims 1-24 (canceled)

**Claim 25 (currently amended):** ~~The method of claim 1, wherein the NAALADase inhibitor~~  
is A method for treating retinopathy, age-related macular degeneration or glaucoma comprising  
administering to a mammal in need of such treatment an effective amount of a compound of  
 formula X



X

or an enantiomer or a pharmaceutically acceptable equivalent of said compound, wherein:

$X^3$  is  $-(CR^{36}R^{37})_nSH$ ,  $-O(CR^{36}R^{37})_2SH$ ,  $-S(CR^{36}R^{37})_2SH$  or  $-NR(CR^{36}R^{37})_2SH$ ;

n is 1-3; and

R,  $R^{36}$ ,  $R^{37}$ ,  $A^6$ ,  $A^7$ ,  $A^8$  and  $A^9$  are independently hydrogen,  $C_1$ - $C_9$  alkyl,  $C_2$ - $C_9$  alkenyl,  $C_2$ - $C_9$  alkynyl, aryl, heteroaryl, carbocycle, heterocycle, halo, hydroxy, sulfhydryl, nitro, amino, cyano, isocyano, thiocyno, isothiocyno, formamido, thioformamido, sulfo, sulfinio,  $C_1$ - $C_9$  alkylsulfonyl,  $C_1$ - $C_9$  alkoxy,  $C_2$ - $C_9$  alkenoxy, phenoxy or benzyloxy, wherein said alkyl, alkenyl, alkynyl, aryl, heteroaryl, carbocycle, heterocycle, alkoxy, alkenoxy, phenoxy and benzyloxy are independently unsubstituted or substituted with one or more substituent(s).

**Claim 26 (original)** The method of claim 25, wherein the compound of formula X is selected from the group consisting of:

3-(2-mercaptoethyl)-benzoic acid;  
3-(mercaptomethyl)-benzoic acid;  
2-(mercaptomethyl)-benzoic acid;  
5-hydroxy-2-(2-mercaptoethyl)-benzoic acid;  
2-(2-mercaptoethyl)-benzoic acid;  
5-[(4-carboxyphenyl)methoxy]-2-(2-mercaptoethyl)-benzoic acid;  
2-(2-mercaptoethyl)-5-(phenylmethoxy)-benzoic acid;  
2-(carboxymethoxy)-6-(2-mercaptoethyl)-benzoic acid;  
5-[(3-carboxyphenyl)methoxy]-2-(2-mercaptoethyl)-benzoic acid;  
2-(2-mercaptoethyl)-6-(phenylmethoxy)-benzoic acid;  
2-[(2-carboxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-[(4-carboxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
3-(2-mercaptoethyl)-[1,1'-biphenyl]-2,3'-dicarboxylic acid;  
2-(3,3-dimethylbutoxy)-6-(2-mercaptoethyl)-benzoic acid;  
2-(2-mercaptoethyl)-6-(2-phenylethoxy)-benzoic acid;  
2-[(2-chlorophenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-[[3-carboxy-5-(1,1-dimethylethyl)phenyl]methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-(2-mercaptoethyl)-6-phenoxy-benzoic acid;  
2-(2-mercaptoethyl)-6-phenylamino-benzoic acid;  
2-(2-mercaptoethyl)-6-(phenylthio)-benzoic acid;  
5'-(1,1-dimethylethyl)-3-(2-mercaptoethyl)-[1,1'-biphenyl]-2,3'-dicarboxylic acid;  
3-(2-mercaptoethyl)-[1,1'-biphenyl]-2,4'-dicarboxylic acid;  
2-[(4-carboxy-2-methoxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-[(4-carboxy-3-methoxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-[(2-bromo-4-carboxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-[(3-bromo-4-carboxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-[(4-chlorophenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-(biphenyl-2-ylmethoxy)-6-(2-mercaptoethyl)-benzoic acid;



*A1  
Cnid*

2-[(3-bromo-5-carboxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-[(2-bromo-5-carboxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-(2-mercaptoethyl)-6-[(4-methoxyphenyl)methoxy]-benzoic acid;  
2-(2-mercaptoethyl)-6-[(4-methylphenyl)methoxy]-benzoic acid;  
2-[(4-bromo-3-carboxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
2-[(2-carboxy-5-methoxyphenyl)methoxy]-6-(2-mercaptoethyl)-benzoic acid;  
5-(mercaptomethyl)-2-(2-phenylethoxy)-benzoic acid;  
2-bromo-5-(mercaptomethyl)-benzoic acid;  
4-(mercaptomethyl)-[1,1'-biphenyl]-2,3'-dicarboxylic acid;  
5-(mercaptomethyl)-2-(phenylmethoxy)-benzoic acid; and  
4-bromo-3-(mercaptomethyl)-benzoic acid; and  
enantiomers and pharmaceutically acceptable equivalents.

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**Claims 27-49 (canceled)**

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*1*  
**Claim 50 (new):** The method of claim 25, wherein the method is for treating retinopathy.

**Claim 51 (new):** The method of claim 50, wherein the retinopathy is diabetic retinopathy.

**Claim 52 (new):** The method of claim 25, wherein the method is for treating age-related macular degeneration.

*12*  
**Claim 53 (new):** The method of claim 25, wherein the method is for treating glaucoma.

**Claim 54 (new):** The method of claim 26, wherein the method is for treating retinopathy.

**Claim 55 (new):** The method of claim 54, wherein the retinopathy is diabetic retinopathy.

**Claim 56 (new):** The method of claim 26, wherein the method is for treating age-related macular degeneration.

**Claim 57 (new):** The method of claim 26, wherein the method is for treating glaucoma.

*AP  
cont*  
**Claim 58 (new):** A method for treating retinopathy or age-related macular degeneration comprising administering an effective amount of a NAALADase inhibitor to a mammal in need of such treatment.

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**REMARKS**

Claims 1-24 and 27-49 are cancelled and claim 25 is amended to remove non-elected subject matter. New claims 50-58 are added. Upon entry of the foregoing amendments, claims 25, 26 and 50-58 would be pending.

Applicants respectfully request reconsideration of this application in view of the foregoing amendments and in view of the reasons which follow.

**35 U.S.C. 102(e)**

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Meyerhoff et al. In support of this rejection, the Office action states: "Meyerhoff et al. Teach [sic] the use of a NAALADase inhibitor for the treatment of glaucoma."

The foregoing amendments obviate this rejection.

### CONCLUSION

Applicants believe that this application is now in condition for allowance. Favorable reconsideration of this application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of this application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date May 12, 2003

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**ACTUAL FILE HISTORY**  
U.S. Application No. 09/866,961  
Attorney Docket No.: 054707-0868

<b>Date Mailed</b>	<b>File History</b>	<b>Comments</b>
09/21/2004	Notice of Abandonment	
09/10/2004	Petition Decision	Group Director treats request filed July 19, 2004, as a Petition under 37 C.F.R. § 1.181
08/09/2004	Interview Summary	Examiner Fay agrees to withdraw final Office Action and Advisory Action
07/29/2004	Interview Summary	SPE Low agrees to vacate final Office Action and Advisory Action
07/19/2004	Request for Withdrawal of Office Actions	
07/07/2004	Advisory Action	
04/08/2004	Informal fax submitting copy of 12/16/2003 response	
02/26/2004	Informal fax submitting copy of 12/16/2003 response	
01/29/2004	Final Office Action	Refers to Response filed 10/17/2003
12/16/2003	Response to Office Action of 09/16/2003	Transmitted via facsimile
09/16/2003	Non-final Office Action	
05/12/2003	Response to Office Action of 02/14/2003	
02/14/2003	Non-final Office Action	
11/12/2002	Response to Restriction Requirement	
10/23/2002	Restriction Requirement	
03/28/2002	Second Information Disclosure Statement	
08/30/2001	Information Disclosure Statement	
08/15/2001	Updated Filing Receipt	
08/15/2001	Withdrawal of Previously Sent Notice	Disregard Notice sent 7/26/01
07/26/2001	Notice to File Missing Parts	
07/26/2001	Filing Receipt	
05/30/2001	Application Filed	